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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 10/30/2003
Gerard F. Dunne
156 Fifth Avenue Suite 1223
New York, NY 10010

EXAMINER

STERLING, AMY JO

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,423

Applicant(s)

NOVAK ET AL.

Examiner

Amy J. Sterling

Art Unit

3632

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,9,14 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,8,9 and 14 is/are allowed.
- 6) ☒ Claim(s) 17,18 and 20 is/are rejected.
- 7) ☒ Claim(s) 19 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is the **Final Office Action** for application number 09/909,423 Decorative Gift Bag Balloon Holder, filed on 7/19/01. Claims 1-3, 8, 9, 14, 17-24 are pending. This **Final Office Action** is in response to applicant's reply dated 10/8/03, paper no. 20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

According to the Revised Amendment Practice as of 37 CFR 1.121 which can be found on website <http://www.uspto.gov/web/patents/ifw/>, required as of July 30, 2003, cancelled and withdrawn claims should be indicated by only the claim number and status. The text of cancelled or withdrawn claims should not be presented. The amendment, dated 10/8/03 presents the text of cancelled claims 4-7, 10-13, 15-16 and 21. The amendment has, however, been entered.

Claim Rejections - 35 USC § 102

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5441348 to Valentino.

The patent to Valentino discloses a decorative bag means having a core (16) formed of a weighty material adapted to hold a plurality buoyant balloon in place and positioned within the decorative bag, the decorative bag means having decorative

material (20) secured within the decorative bag via the core in a position to conceal the core from casual view, the bag holder which could be adapted to be displayed for retail sale and for having decorative appeal.

Claim Rejections - 35 USC § 103

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 4930903 to Mahoney.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core is secured to the interior of the bag.

Mahoney shows a core (14, 48) which is secured to the inside of the interior of a decorative gift bag, used so that the core does not fall out of the bag when moved or tipped. (See Col. 2, lines 46-50). Therefore, it would have been obvious to someone skilled in the art to have modified the core of Valentino to be secured to the bag, in order to make the device less likely to come apart upon moving or tipping the device.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 5016848 to Metz.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core has sidewalls generally trapezoidal in shape to taper towards the upper portion.

Metz shows a balloon holding device (10) which has a core (11, 12) for weighting the balloons to a desired surface, the core (11, 12) having a generally trapezoidal shape which tapers towards the upper portion, used so that more balloons could be attached to the device, if so desired or to add weight to the bag, so that it does is not easily moved while subjected to an outside force of some kind. Therefore, it would have been obvious to someone skilled in the art to have changed the shape of the core as taught by Valentino, in order to be able to hold the bag in the desired location while being subjected to an outside force.

Response to Arguments

The applicant has argued that the claim 17 is allowable because as amended the Valentino reference does not teach the limitations of the core being a mass of dense, weighty material providing sufficient weight to hold a plurality of buoyant balloons. This is unpersuasive because “dense” and the “weight of a plurality of buoyant balloons” are relative terms, with infinite embodiment possibilities. For example, air could be considered a dense mass, as compared to a mass of helium, or a cardboard core could be considered dense in comparison with the air mass. A plurality of buoyant balloons has the same subjective definition, a cardboard core may be weighty enough to hold one or two large balloons or several smaller balloons, depending on the size and density of the cardboard and the size and density of the gas which inflates the balloon to make it buoyant. The term “buoyant” is also considered relative to the gas or liquid in

which it floats, thereby making the term buoyant subjective as well. Therefore the claim as amended is not patentable over the art cited.

In response to applicant's argument that "the balloon holder is displayed for retail sale for providing decorative appeal for the balloon holder at retail display", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

There is reason to believe, based on the similarity of the structures recited that the functional limitations of the "retail sale display" may be an inherent characteristic of the balloon holder. In accordance with In re Best, 562 1252, 195 USPQ 430, 433 (CCPA 1977):

Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Accordingly, the burden is placed upon the applicant to prove that the functional limitation of having the decorative bag balloon holder to be placed on retail display, is not an inherent characteristic of the decorative bag taught by Valentino and Mahoney.

The applicant has also argued that it would not be obvious to change the shape of the core in order to "hold more balloons". In response to applicant's argument that there is no suggestion to combine these references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to change the shape of the core is found in adding more weight to the core in order to hold the decorative bag in the desired location while subjecting it to an outside force.

Allowable Subject Matter

Claims 19, 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-3, 8, 9 and 14 are allowed. The reason is that the prior art does not show a decorative balloon holder having the handles extending from the upper portion of the bag which are secured together. Also the prior art does not show where the core is formed of a compressed sand held by adhesive or a sand, cement and water mixture.

The reference to Metz shows the balloon holder (10) being filled with loose sand or ballast.

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is

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703-872-9306 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS
Amy J. Sterling
10/26/03



RAMON O. RAMIREZ
PRIMARY EXAMINER
ART UNIT 355 3632